



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In the matter of the Application of: Shyjan, et al.

Application No.: 09/374,554

Filing Date: August 13, 1999

For: *Methods and Compositions for the Identification  
and Assessment of Cancer Therapies*

Attorney Docket No.: MRI-005CP2CPA

Group Art Unit: 1655

Examiner: Goldberg, J.

Commissioner for Patents  
Washington, D.C. 20231

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October 5, 2001

By:

DeAnn F. Smith

Reg. No. 36,683

Attorney for Applicants

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the restriction requirement set forth in the Office Action dated April 10, 2001 (Paper No. 8).

The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

- I. Claims 1, 2, 4-5, 10-11, 13-14, 16-17, 19-20, 25-26, 28-29, 31, 34, and 40 drawn to a method for determining whether an agent can be used to reduce the growth of cancer cells by obtaining a sample and determining whether

cancer cells express sensitivity genes (Tables 8B, 10B, and 11B) to identify an agent which can be used to reduce growth of cancer cells by detecting the amount of mRNA that is encoded by the sensitivity genes, classified in class 435, subclass 6.

- II. Claims 1-2, 7-8, 10-11, 13-14, 16-17, 22-23, 25-26, 28-29, 31, 37, and 40 drawn to a method for determining whether an agent can be used to reduce the growth of cancer cells by obtaining a sample and determining whether cancer cells express sensitivity genes (Tables 8B, 10B, and 11B) to identify an agent which can be used to reduce growth of cancer cells by detecting the amount of protein present that is encoded by the sensitivity genes, classified in class 435, subclass 7.1.
- III. Claims 3, 6, 12, 15, 18, 21, 27, 30, 32-33, 35-36, and 40 drawn to a method for determining whether an agent cannot be used to reduce the growth of cancer cells by obtaining a sample and determining whether cancer cells express resistance genes (Tables 8A, 9A, 9B, 9C, 9D, 10A, and 11A) to identify an agent which can be used to reduce growth of cancer cells by detecting the amount of mRNA that is encoded by the resistance genes, classified in class 435, subclass 6.
- IV. Claims 3, 9, 12, 15, 18, 24, 27, 30, 32-33, and 38-40 drawn to a method for determining whether an agent cannot be used to reduce the growth of cancer cells by obtaining a sample and determining whether cancer cells express resistance gene (Tables 8A, 9A, 9B, 9C, 9D, 10A, and 11A) to identify an agent which can be used to reduce growth of cancer cells by detecting the amount of protein present that is encoded by the resistance genes, classified in class 435, subclass 7.1.

Applicants hereby elect the Group III invention (claims 3, 6, 12, 15, 18, 21, 27, 30, 32-33, 35-36, and 40) for prosecution in this application.

It is the Applicants' understanding that under 35 U.S.C. §121, an election of a single species for prosecution on the merits is required, to which the claims will be

restricted if no generic claim is finally held allowable. Therefore, Applicants elect clone D28137 (BST2) from Table 9B.

## SUMMARY

If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' Attorney at (617) 227-7400.

Respectfully submitted,



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Dated: October 5, 2001